

Appl. No. 10/722,641
Amtd. dated Dec. 28, 2004
Reply to Office action of Jul. 28, 2004

REMARKS

In response to the Office Action dated June 25, 2004, Applicant respectfully requests reconsideration based on the above claim amendment and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claim 6 has been canceled without prejudice and claims 1 and 4 have been amended leaving claims 1-5, 7 and 8 for examination upon entry of the present amendment. The title has been amended to particularly state the invention to which the claims are directed. The drawings have been amended to conform to the Examiner's instructions. The amendment is fully supported by the disclosure. No new matter has been added by the amendment.

Claim Rejections Under 35 U.S.C. §102(e)

Claims 1-2 and 4-8 were rejected under 35 U.S.C. §102(b) as being anticipated by Toyooka, U.S. Patent No. 6,752,946 (hereinafter "Toyooka").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is submitted that Toyooka fails to teach each and every element as set forth in amended claim 1 for at least the reasons described below. Claim 6 has been cancelled without prejudice, thus the rejection of claim 6 is now moot.

Applicant has amended claim 1 to recite, *inter alia*, injection-molding buttons on the inner surface of the button placing portions of the external pad so that the buttons are integrally formed with the external pad. In contrast, Toyooka merely discloses a method for injection molding a housing for a cellular phone top cover, absent buttons. In the rejection of claim 1, the Examiner has indicated that Toyooka teaches all the elements of the method claimed in the present invention. Applicant respectfully traverses the Examiner's analysis. Toyooka discloses a method for molding a housing 17 at an interior surface of the external pad 1, at col. 9, line 4 to col. 12, line 24. However, the method taught in Toyooka does not include the step of injection-molding buttons so that the buttons are integrally formed with the external pad, as recited in amended claim 1. To the contrary, Toyooka teaches in col. 12, lines 30 to 35, that the housing is "fitted with" "push buttons or the like." Thus, Toyooka teaches that push buttons are added after

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the fabrication process and not as a step of the fabrication process as disclosed in the present invention. Additionally, the push buttons of Toyooka are "fitted" and not injection-molded at a designated portion of the external pad so that the push buttons disclosed in Toyooka are not integrally formed with the external pad. Thus, Toyooka fails to teach the step injection-molding buttons on the inner surface of the button placing portions of the external pad so that the buttons are integrally formed with the external pad, as claimed in amended claim 1.

Further, the Applicant has amended claim 1 to recite, *inter alia*, disposing a transparent display window at the transparent display window placing portion. In contrast, Toyooka teaches in col. 9, lines 26 to 28, and again in col. 9, lines 30 to 34, that the external pad 1 defines the transparent display window 21. Thus, Toyooka fails to teach the step disposing a transparent display window at the transparent display window placing portion, as claimed in amended claim 1.

In summary, it is respectfully submitted that Toyooka teaches neither injection-molding buttons on the inner surface of the button placing portions of the external pad so that the buttons are integrally formed with the external pad, nor disposing a transparent display window at the transparent display window placing portion, as recited in amended claim 1.

Accordingly, claim 1 is believed to be patentably distinct and nonobvious in view of Toyooka. Claims 2, 4, 5, 7 and 8 depend either directly or indirectly from claim 1, thus include all the limitations of claim 1. Thus, claims 2, 4, 5, 7 and 8 are believed to be allowable for at least the reasons given for claim 1, which is believed to be allowable.

Accordingly, Applicant respectfully requests that the Examiner reconsider the rejections of claims 1, 2, 4, 5, 7 and 8 under 35 U.S.C. §102(e).

Claim Rejections Under 35 U.S.C. §103(a)

In order for an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the

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skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). See MPEP 2143.

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Toyooka in view of Noritomi, U.S. Patent No. 5,795,525 (hereinafter "Noritomi").

As mentioned above, Toyooka fails to teach either injection-molding buttons on the inner surface of the button placing portions of the external pad, or disposing a transparent display window at the transparent display window placing portion as recited in amended claim 1. Noritomi is directed to a method for assembling a control panel. There is no disclosure or suggestion in Noritomi of either injection-molding buttons on the inner surface of the button placing portions of the external pad, or disposing a transparent display window at the transparent display window placing portion as claimed in amended claim 1. Thus the cited references do not render claim 1 obvious. Claim 3 depends directly from claim 1, thus includes all the limitations of claim 1. The dependent claim 3 is patentable for at least the same reasons as given above for the independent claim 1.

Accordingly, Applicant respectfully requests the Examiner's reconsideration of the rejection of claim 3.

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Conclusion

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicant's attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

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